



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 2023
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JAN 5 2001

In re

)
)
) Decision on
) Petition for Regrade
) Under 37 C.F.R. § 10.7(c)
)

MEMORANDUM AND ORDER

(petitioner) requests for regrading his answers to questions 1, 8, 11, 18 and 30 of the morning section and to questions 10, 11, 23, 28, 47 and 48 of the afternoon section of the Registration Examination held on April 12, 2000. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 67. On July 25, 2000, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Director of the USPTO.

OPINION

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement *true*. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO," "PTO," or "Office" are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded a point for morning question 20. Accordingly, petitioner has been granted one additional point on the Examination, resulting in a regraded score of 68.

However, no credit has been awarded for morning questions 1, 8, 11, 18 and 30 and for afternoon questions 10, 11, 23, 28, 47 and 48. Petitioner's arguments for these questions are addressed individually below.

Morning question 1 reads as follows:

1. The claimed invention in a patent application is directed to an explosive composition "comprising 60-90% solid ammonium nitrate, and 10-40% water-in-oil in which sufficient aeration is entrapped to enhance sensitivity to a substantial degree." The application discloses that the explosive requires both fuel (the ammonium nitrate), and oxygen to "sensitize the composition." A prior art reference, published more than two years before the effective filing date of the application, discloses explosive compositions containing water-in-oil emulsions having identical ingredients to those claimed, in ranges overlapping with the claimed composition. The only element of the claim not recited in the reference is "sufficient aeration entrapped to enhance sensitivity to a substantial degree." The reference does not recognize that sufficient aeration sensitizes the fuel to a substantial degree. However, in fact, "sufficient aeration" is necessarily an inherent element in the prior art blasting composition within the overlapping ranges inasmuch as the blasting composition explodes. The prior art reference:

- (A) anticipates the claim because it discloses every limitation of the claim either explicitly or inherently.
- (B) does not anticipate the claim because the prior art reference does not recognize an inherent property.
- (C) does not anticipate the claim because the prior art reference does not recognize an inherent function of oxygen.
- (D) does not anticipate the claim because the prior art reference does not recognize an inherent ingredient, oxygen.
- (E) (B), (C) and (D).

The model answer is choice (A). The prior art reference anticipates the claim because it discloses every limitation of the claim either explicitly or inherently.

Petitioner argues that (D) is correct. Petitioner argues that (A) is not the correct answer because in the claimed invention, the sufficient aeration modifies the water-in-oil, however the prior art reference does not disclose what is modified. Petitioner argues that as a result the

aeration could be associated with the aluminum nitrate and the composition could be a different composition. Petitioner argues that since there is no inherent teaching regarding the important details, one cannot assume that the properties are inherent.

Petitioner's arguments have been fully considered but they are not persuasive. When a patent claims a composition in terms of ranges of an element, any single prior art reference falling within each of the ranges anticipates the claim. *Atlas Powder Co. v. IRECO, Inc.*, 51 USPQ2d 1943 (Fed. Cir. 1999) (holding "[i]nherency is not necessarily coterminous with knowledge of those of ordinary skill in the art...Artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art... However, the discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition new to the discoverer." The court also held that "this same reasoning holds true when it is not a property, but an ingredient, which is inherently contained in the prior art."). The facts state that "sufficient aeration" is necessarily an inherent element in the prior art blasting composition within the overlapping ranges inasmuch as the blasting composition explodes. Thus, based on the fact given and the existing case law, the rejection should be made. Answer (A) is correct and answer (D) is incorrect.

Morning question 8 reads as follows:

8. Applicant received a Final Rejection with a mail date of Tuesday, February 29, 2000. The Final Rejection set a 3 month shortened statutory period for reply. Applicant files an Amendment and a Notice of Appeal on Monday, March 27, 2000. The examiner indicates in an Advisory Action that the Amendment will be entered for appeal purposes, and how the individual rejection(s) set forth in the final Office action will be used to reject any added or amended claim(s). The mail date of the examiner's Advisory Action is Wednesday, May 31,

2000. Which of the following dates is the last date for filing a Brief on Appeal without an extension of time?

- (A) Saturday, May 27, 2000.
- (B) Monday, May 29, 2000 (a Federal holiday, Memorial Day).
- (C) Tuesday, May 30, 2000.
- (D) Wednesday, May 31, 2000.
- (E) Tuesday, August 29, 2000.

The model answer is choice (D). The last date for filing a Brief on Appeal without an extension of time is May 31, 2000.

Petitioner argues that (E) is correct. Petitioner argues that he was not clear if the question was asking about an extension of time to respond to the office action or an extension of time to file the appeal brief. Petitioner asserts that he knew of extensions of time available under 37 C.F.R. 1.136(a) and therefore chose answer (E). Since the question is ambiguous (E) should be accepted as a correct response.

Petitioner's arguments have been fully considered but they are not persuasive. The question clearly asks what is the last date for filing the brief without an extension of time. As explained in MPEP § 710.02(e), "If an applicant initially replies within 2 months from the date of mailing of any final rejection setting a 3-month shortened statutory period for reply and the Office does not mail an advisory action until after the end of the 3-month shortened statutory period, the period for reply for purposes of determining the amount of any extension fee will be the date on which the Office mails the Advisory Action advising applicant of the status of the application..." Accordingly, the last date that the applicant may file an appeal brief without an extension of time is May 31, 2000, the mailing date of the Advisory Action. Answer (D) is correct and answer (E) is incorrect.

Morning question 11 reads as follows:

Please answer questions 10 and 11 based on the following facts. Mario Lepieux was a member of a Canadian national hockey team touring Europe. While traveling through Germany (a WTO member country) in December 1998, Mario conceived of an aerodynamic design for a hockey helmet that offered players improved protection while reducing air resistance during skating. Upon Mario's return to Canada (a NAFTA country), he enlisted his brothers Luigi and Pepe Lepieux to help him market the product under the tradename "Wing Cap." On February 1, 1999, without Mario's knowledge or permission, Luigi anonymously published a promotional article written by Mario and fully disclosing how the Wing Cap was made and used. The promotional article was published in Moose Jaw Monthly, a regional Canadian magazine that is not distributed in the United States. The Wing Cap was first reduced to practice on March 17, 1999. A United States patent application properly naming Mario as the sole inventor was filed September 17, 1999. That application has now been rejected as being anticipated by the Moose Jaw Monthly article.

11. Which of the following statements is most correct?

- (A) In a priority contest against another inventor, Mario can rely on his activities in Canada in establishing a date of invention.
- (B) In a priority contest against another inventor, Mario can rely on his activities in Germany in establishing a date of invention.
- (C) Mario can rely on his activities in Canada in establishing a date of invention prior to publication of the regional Canadian magazine article.
- (D) (A) and (C).
- (E) (A), (B), and (C).

The model answer is choice (E). Mario can rely on his activities in Germany and Canada in establishing a date of invention.

Petitioner argues that (C) is correct. Petitioner argues that Answer (E) is incorrect because the fact pattern does not state anything about other patent applications or inventors. Answers (A) and (B) are directed to a priority contest against another inventor, therefore the examinee would be required to assume facts not given in the question.

Petitioner's arguments have been fully considered but they are not persuasive. The answer choices are part of the question. Thus, the examinee is not asked to presume facts not presented. While the reduction to practice occurred after the date of publication of the article, Mario may rely on his activities in Canada in establishing his date of invention by showing due diligence after conception. See MPEP 715.07. Since, the article is a publication of Mario's own work and not a statutory bar, he may rely on his activities in Canada. See 35 U.S.C. § 104; see also MPEP § 715.01(c). Answer (E) is the most correct answer.

Morning question 18 reads as follows:

18. Which of the following is NOT a policy underlying the public use bar of 35 U.S.C. § 102(b)?

- (A) Discouraging the removal, from the public domain, of inventions that the public reasonably has come to believe are freely available.
- (B) Favoring the prompt and widespread disclosure of inventions.
- (C) Allowing the inventor(s) a reasonable amount of time following sales activity to determine the potential economic value of a patent.
- (D) Increasing the economic value of a patent by extending the effective term of the patent up to one year.
- (E) Prohibiting the inventor(s) from commercially exploiting the invention for a period greater than the statutorily prescribed time.

The model answer is choice is (D). Increasing the economic value of a patent by extending the effective term of the patent up to one year is NOT a policy underlying the public use bar of 35 U.S.C. § 102(b).

Petitioner argues that answer (C) is also correct, because it is not entirely correct.

Petitioner argues that (C) refers to patent and not invention. Thus, the answer is not correct.

Petitioner argues that the policy is to allow time to determine the value of the invention, thus the

answer is incorrect. Petitioner also argues that if the policy is to allow time to value a patent that one year would not be enough time.

Petitioners' arguments have been fully considered but they are not persuasive. Answer (C) states the potential value of a patent, i.e., whether or not it is advantageous to seek a patent. The Court of Appeals for the Federal Circuit has repeatedly stated that one of the policies underlying the public use bar of 35 U.S.C. 102(b) is allowing inventors a reasonable amount of time following sales activities to determine the potential economic value of a patent. Note *Lough v. Brunswick Corp.*, 86 F.3d 1113, 39 USPQ2d 1100 (Fed. Cir. 1996); *Tone Brothers v. Sysco Corp.*, 28 F.3d 1192, 31 USPQ2d 1321 (Fed. Cir. 1994); and *King Instrument Corp. v. Otari Corp.*, 767 F.2d 853, 226 USPQ 402 (Fed. Cir. 1985). Thus, choice (C) is incorrect. The Federal Circuit lists all of the answer choices, with the exception of choice (D) (i.e., increasing the economic value of a patent by extending the effective term of the patent up to one year) as policies underlying the public use bar of 35 U.S.C. 102(b). Thus, choice (D) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 30 reads as follows:

30. On February 8, 1999, you prepared and filed a patent application for Smith disclosing and claiming a new method for heating automobile windshields. The specification disclosed connecting a variable voltage source to a resistive heating element, connecting the heating element to the windshield, and adjusting the voltage of the voltage source to an effective amount. The specification stated certain advantages of heating automobile windshields by the invention's method, including protecting the internal structure of the glass from cracking, and defrosting the glass. The specification also fully disclosed guidelines adequately explaining that an effective amount of voltage to protect windshield glass from cracking was at least 0.5 volts, regardless of the outside temperature. The specification disclosed that an effective amount of voltage for defrosting windshields was at least 1.0 volt, regardless of the outside temperature. Claim 1 stated the following:

Claim 1. A method for heating an automobile windshield, comprising: connecting a variable voltage source to a resistive heating element; connecting the resistive heating element to the automobile windshield; and adjusting the voltage source to an effective amount of voltage.

You received a non-final Office action, dated February 4, 2000, rejecting claim 1 only under 35 U.S.C. § 112, second paragraph. The rejection stated that the use of the limitation, "an effective amount of voltage," rendered the claim indefinite. Which, if any, of the following actions, taken by you, comport with proper PTO rules and procedure, and will overcome the rejection?

I. Filing an appeal with a brief, on August 3, 2000, arguing that the only remaining issue is the definiteness of claim 1, and that the claim is not rendered indefinite by the use of the limitation, "an effective amount of voltage," since guidelines in the specification fully disclosed what "an effective voltage" would be.

II. Filing a reply on May 4, 2000, traversing the rejection on the grounds that claim 1 is not rendered indefinite by the use of the limitation, "an effective amount of voltage," since guidelines in the specification fully disclosed what "an effective voltage" would be.

III. Filing a reply on May 4, 2000, amending the limitation, "an effective amount of voltage" to read, "an effective amount of voltage for defrosting the automobile windshield".

- (A) I.
- (B) II.
- (C) III.
- (D) II and III.
- (E) I, II, and III.

The model answer is choice is (C). A reply amending the limitation "an effective amount of voltage" to read, "an effective amount of voltage for defrosting the automobile windshield" would comport with proper PTO rules and procedure, and will overcome the rejection.

Petitioner argues that answer (D) is correct. Petitioner asserts that parts (II) and (III) are both correct answers making answer (D) the correct answer. Petitioner argues that the preamble can also determine the scope of the claim and that the specification sets forth the two specific applications for heating the windshield. Petitioner argues that the claim is directed to a method of heating an automobile windshield, thus one skilled in the art would know according to the disclosure the effective amount required for heating the windshield.

Petitioner's arguments have been fully considered but they are not persuasive. Answer (D) includes choice II, which is incorrect because the phrase "an effective amount of voltage" has two different functions, i.e., to "protect windshield glass from cracking" and "for defrosting windshields." See MPEP § 2173.05(c), section III. A claim has been held to be indefinite when the claim, as in this case, fails to state which of two disclosed functions is to be achieved. It is not clear which function is related to the phrase in the claim. In this instance, it is not clear which of the two functions "an effective amount" is addressing. Answer (D) is incorrect and answer (C) is the most correct answer.

Afternoon question 10 reads as follows:

10. On December 1, 1998, Sam, attorney for the firm of Thrill and Chill, files a request for reexamination of a patent owned by his client, Hurley Corp., along with a recently discovered Russian patent which issued more than one year before the filing date of the patent. Hurley's patent contains one independent claim and nine dependent claims. The request for reexamination is granted on February 1, 1999. On June 1, 1999, an Office action issues in which the Examiner properly rejects independent claim 1 under 35 U.S.C. §§ 102 and 103 using the Russian reference and objects to the remaining claims as being dependent upon a rejected claim. Sam receives the Office action, agrees with the Examiner that claim 1 is unpatentable over the Russian patent and forwards it to his client, Hurley Corp. Hurley Corp. is undergoing financial problems and files for bankruptcy protection with the Federal District Court. They advise Sam that they have no funds available to further prosecute the reexamination proceeding. In accordance with proper PTO practice and procedure what should Sam do?

- (A) Advise the Examiner on the telephone that the patentee has filed for bankruptcy protection, and that nothing should be done in the reexamination proceeding until the bankruptcy is settled.
- (B) Do nothing and a reexamination certificate will issue indicating that claim 1 is canceled and that the patentability of claims 2 - 10 is confirmed.
- (C) File a fallacious reply arguing the patentability of claim 1 in order to allow the reexamination proceeding to continue.
- (D) File a divisional reexamination proceeding whereby claims 2 through 10 will be transferred into the divisional and allowed to issue. Claim 1, still in the original

reexamination proceeding, can then be appealed to the Board of Patent Appeals and Interferences at a later point in time after the bankruptcy is resolved.

- (E) Send a letter to his client Hurley Corp. advising them that unless he is paid in advance, he will take no further action in the proceeding and file no papers with the PTO.

The model answer is choice B, do nothing and a reexamination certificate will issue indicating that claim 1 is canceled and that the patentability of claims 2 - 10 are confirmed.

Petitioner selected answer E. Petitioner argues that the practitioner has only put the client on notice, but has not told the client that he will no longer represent him. Petitioner argues that answer E is correct because there is no approaching deadline and the attorney has not told the client that he wished to stop representation.

Petitioner's arguments have been fully considered but they are not persuasive. The attorney has been told by his client that he does not have funds to continue prosecution. If the attorney does nothing as stated in choice B, a Reexamination Certificate will issue confirming the patentability of dependent claims 2-10. See MPEP §§ 2287 and 2288. An amendment incorporating the limitations of independent claim 1 into the dependent claims 2-10 is not required. Since the attorney agrees with the rejection of claim 1, the client would not be adversely affected.

Choice E is not the best answer because Sam should not charge his client in advance for services that are not required in the reexamination proceeding. To resolve any payment issues for services rendered, Sam should request to withdraw and obtain permission from the PTO in accordance with 37 C.F.R. 10.40 and MPEP 402.06.

Afternoon question 11 reads as follows:

11. Which of the following is true?

(A) The differences between a continuation application and a continuation-in-part (C-I-P) application include: (1) new matter can be added when a C-I-P is filed and (2) the inventive entity in an original application and continuation application must be the same, whereas only one common inventor is necessary between an original application and a CIP application.

(B) A reissue applicant's failure to timely file a divisional application is error and proper grounds for filing a reissue application.

(C) A patent claiming a process is shown to be inoperative by showing no more than that it is possible to operate within the disclosure of the patent without obtaining the alleged product.

(D) Where appeal to the Board of Patent Appeals and Interferences is dismissed for failure to argue a ground of rejection involving all the appealed claims, but allowed claimed remain in the application, the application becomes abandoned.

(E) None of the above.

The model answer is choice (E). None of the statements are true.

Petitioner argues that answer (A) is also correct. Petitioner argues that since the question did not specify any exception to the general rule of 37 CFR 1.53(d)(iii), a continuation application, by default, should list the same inventors as in the original application and the exception provided in 37 CFR 1.53(d)(4) should not apply.

Petitioner's arguments have been fully considered but they are not persuasive. The statement in answer (A) states that the inventive entity of an original application and continuation application **must** be the same. This statement is not true because a continuation application that **names as inventors the same or fewer than all the inventors named in the prior application** may be filed under 37 CFR 1.53(b)(1) or 37 CFR 1.53(d). See 37 CFR 1.53(b)(1). Furthermore, as **stated in MPEP 201.07**, a continuation need only have one inventor in common. Thus, answer (A) is incorrect.

Afternoon question 23 reads as follows:

23. In 1998, Chris invents an automobile or truck windshield wiper device that uses a transparent grid to automatically sense water drops on the windshield and wipe the window whenever a drop appears. The grid detects current variations when moisture impregnates the grid, and then activates the windshield wiper. In April 1998, Chris submitted an article for publication in Popular Scientist magazine disclosing the invention. The magazine edited the article to the extent that the article, published August 1, 1998, fails to enable one of ordinary skill in the art to make the invention. On August 31, 1998, Chris offers the automobile windshield wiper device for sale to the Ajax Motor Company, leaving a sample device for use in automobiles at the Ajax plant. Chris knew his device can be used with trucks only if the sensors are modified to accommodate the larger windshields, however no such modification has been made. Without Chris' knowledge, Ajax intends to use the device on its trucks. Ajax modifies and successfully tests the device using larger sensors for trucks on a public highway on September 1, 1998. Chris files a patent application with the PTO for the basic concept for automotive windshields on August 2, 1999. On August 30, 1999, Chris realizes that Ajax modified his invention to work with trucks on September 1, 1998, and that his claims do not cover the truck embodiment. There is no basis in the application supporting a claim directed to the embodiment for trucks, but the modification would have been obvious to one of ordinary skill in the art. Chris' application has not yet issued. He comes to you, a registered practitioner, for advice on the morning of August 30, 1999 as to whether he should file a new application for his windshield wiper directed to trucks and buses. What should you advise Chris to do in accordance with proper PTO practice and procedure?

- (A) The Popular Scientist publication is a bar under 35 U.S.C. § 102(b) since it was filed over a year before the application was filed.
- (B) Chris can still file a claim in the pending application directed to windshield wipers for trucks because the modification of the sensors would have been obvious to the artisan.
- (C) Chris must file a new application on or before September 1, 1999, to avoid the testing by Ajax from becoming a statutory bar to him obtaining a second patent directed to the windshield wiper for trucks embodiment.
- (D) Chris may file a continuation-in-part application anytime before the first patent application issues in which he can disclose and claim the windshield wiper device for use on trucks and buses since a continuation-in-part is entitled to the parent filing date for everything disclosed in the continuation-in-part application.
- (E) Since the Ajax use of the device on trucks was not discovered until August 31, 1999, Chris has one year from August 31, 1999, to file a new patent application directed to use of his invention on trucks.

The model answer is choice is (C). Chris must file a new application on or before September 1, 1999, to avoid the testing by Ajax from becoming a statutory bar to him obtaining a second patent directed to the windshield wiper for trucks embodiment.

Petitioner selected answer (A). Petitioner argues that the facts do not state that the August publication was nonenabling with regard to the later invention of a truck windshield wiper device. Petitioner argues that since it was not mentioned, the article would be a bar under § 102(b) since it was filed over a year before the application.

Petitioner's arguments have been fully considered but they are not persuasive. With respect to answer (A), the publication in Popular Scientist was not enabling. If the article was nonenabling to one of ordinary skill in the art for a car, then it would have likewise been nonenabling to one of ordinary skill in the art for a truck. Unless it is a statutory bar, a rejection based on a publication may be overcome by a showing that it was published either by applicant himself/herself on his/her behalf. MPEP § 715.01(c). The level of disclosure required within a reference to make it an "enabling disclosure" is the same no matter what type of prior art is at issue. It does not matter whether the prior art reference is a U.S. patent, foreign patent, a printed publication or other. *Cf.* MPEP § 2121. "In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure'..." *In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA 1968). MPEP § 2121.01. Regarding answer (C), the statutory bars of 35 USC 102(b) are applicable even though public use is by a third party. MPEP § 2133.03(e)(7). The statutory bar would apply to the modification by Ajax to use the windshield wiper device on trucks. Thus, answer (A) is incorrect.

Afternoon question 28 reads as follows:

28. Which of the following is **true**?

(A) On appeal of a rejection of ten claims to the Board of Patent Appeals and Interferences, each appealed claim stands or falls separately as a result of appellant pointing out differences in what the claims cover.

(B) The 2-month period for filing a petition mentioned in 37 CFR 1.181(f) is extendable under 37 CFR 1.136(a).

(C) An examiner may enter a new ground of rejection in the examiner's answer to an applicant's appeal brief.

(D) After filing a notice of appeal, an applicant is estopped from further prosecuting the same claims in a continuation application.

(E) When desiring to claim foreign priority, the oath or declaration in a reissue application must claim foreign priority even though the priority claim was made in the original patent.

The model answer is choice is (E). When desiring to claim foreign priority, the oath or declaration in a reissue application must claim foreign priority even though the priority claim was made in the original patent.

Petitioner selected answer (D). Petitioner acknowledges that the current rules permit an applicant to further prosecute the same claims in a continuation application in which a notice of appeal has been filed. Petitioner argues that this procedure seems unethical and should be improper.

Petitioner's arguments have been fully considered but they are not persuasive. See MPEP 1414 Content of Reissue Oath/Declaration and 37 CFR 1.175(a) which states that reissue oaths/declarations must meet the requirements of 37 CFR 1.63, including 1.63(c) relating to a claim for foreign priority. Regarding answer (D), a continuation may be filed during pendency of the parent. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question.

Afternoon question 47 reads as follows:

47. Which of the following actions, if any, when taken as an initial step to dispute the propriety of the finality of an Office action, comports with proper PTO rules and procedure?

I. Filing a request for reconsideration concerning the finality of the Office action, while the application is still pending before the primary examiner.

II. Filing a Notice of Appeal, then a brief, and arguing in the brief the impropriety of the finality of the rejection.

III. Filing a petition under 37 C.F.R. 1.181 based on improper finality of the rejection to stay the running of the period for reply set in the final Office action.

- (A) I. only.
- (B) II. only.
- (C) III. only.
- (D) I. and III.
- (E) None of the above.

The model answer is choice is (A). Filing a request for reconsideration concerning the finality of the Office action, while the application is still pending before the primary examiner comports with proper PTO rules and procedure as an initial step to dispute the propriety of the finality of an Office action.

Petitioner selected answer (D). Petitioner argues that the model answer is incorrect and that (D - both I and III) is the correct answer. Petitioner argues that a 37 CFR 1.181 petition may be filed in which the Commissioner is asked to stay the running period for reply.

Petitioner's arguments have been fully considered but they are not persuasive. The question is "which of the following actions, if any, when taken as an initial step to dispute the propriety of the finality of an Office action, comports with proper PTO rules and procedure?" Choice (A) is a correct answer because the initial step to dispute any question regarde to the prematurity of a final rejection should be raised, if at all, while the application is still pending before the primary examiner.

See MPEP 706.07(c) and (d).

Statement in III is incorrect because the filing of a petition under 37 CFR 1.181 does not stay the period for reply (MPEP 1002) and the required fee has not been paid. Further, the time period is statutory and may not be stayed by the Commissioner. 35 U.S.C. § 133. Thus, answer (D) is incorrect.

Afternoon question 48 reads as follows:

48. Which of the following statements regarding 35 U.S.C. § 103 is most correct?

(A) PTO classification of prior art references used to reject a claim under 35 U.S.C. § 103, and the similarities and differences in structure and function carry equal weight as evidence of whether the references are analogous or non-analogous.

(B) The question of obviousness under 35 U.S.C. § 103 is resolved by determining whether the differences between the prior art and the claims would have been obvious.

(C) Obviousness of an invention can be properly determined by identifying the "gist" of the invention, even where the "gist" does not take into regard an express limitation in the claims.

(D) In delineating the invention, consideration is given not only to the subject matter recited in the claim, but also the properties of the subject matter which are inherent in the subject matter and disclosed in the specification.

(E) Obviousness can be predicated on what is not known at the time an invention is made, where the inherency of the feature is later established.

The model answer is choice (D). Regarding 35 U.S.C. § 103, in delineating the invention, consideration is given not only to the subject matter recited in the claim, but also the properties of the subject matter which are inherent in the subject matter and disclosed in the specification.

Petitioner selected answer (B). Petitioner argues that question 48 is delineating between invention as a whole as opposed to that which is claimed. Petitioner argues that if one looks at the question, then answer (D) is the most correct answer, but if case law is considered and it should be, then (B) is the most correct answer.

Petitioner's arguments have been fully considered but they are not persuasive. "In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question...but also to those properties of the subject matter which are inherent in the subject matter *and* are disclosed in the specification..." *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977); MPEP 2141.02 ("Disclosed Inherent Properties Art Part of 'As A Whole' Inquiry"). Answer (B) is incorrect. MPEP 2141.02. The question under 35 U.S.C. § 103 is whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). While (B) may recite one of the basic tenets from *Graham v. John Deere*, it does not answer the question.

No error in grading has been shown as to morning questions 1, 8, 11, 18 and 30 and afternoon questions 10, 11, 23, 28, 47 and 48.

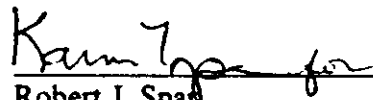
The regrade of the petitioner's examination has been conducted fairly and without discrimination pursuant to a uniform standard using the PTO's model answers. See *Worley v. United States Patent and Trademark Office*, No. 99-1469, slip op. at 4 (D.D.C. Nov. 8, 2000)(The court held that the PTO's Model Answers are a uniform standard. "[S]ince all exams are graded in reference to [the Model Answers], use of the Model Answers fosters uniformity in grading and preclude[s] unfair and individually discriminatory grading." *Id.*, slip opinion at 5. The court concluded that "the decision of the Commissioner of the USPTO not to regrade Mr. Worley's examination answers as correct when the answers did not conform with the USPTO's Model Answers was not arbitrary and capricious." *Id.*, slip opinion at 5-6.)

ORDER

For the reasons given above, one point has been added to petitioner's score on the Examination. Therefore, petitioner's score is adjusted to 68. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.



Robert J. Span
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy